

**Remarks**

Applicants have amended claims 1 and 9 to recite that the secondary layer comprises about 20% to about 35%, by weight, of symmetrically shaped silica particles, and about 65% to about 80% by weight carbon particles, based on the total weight of the friction modifying particles. Claim 11 has been canceled accordingly. Claims 13, 16 and 28 have been amended to recite that the secondary layer comprises 20% to 35% by weight of symmetrically shaped silica particles. Claim 29 has been canceled accordingly.

These amendments are not the addition of new matter. Therefore, Applicants respectfully ask that the Examiner enter the amendments.

Applicants have corrected the informalities pointed out in the claim objections.

Applicants respectfully traverse the rejection of claims 1 – 3, 7 – 17, 28, and 29 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

The Examiner argues that undue experimentation would be required since the specification does not teach or suggest materials resulting in the claimed geometrically symmetrically shaped friction modifying particles.

Applicants respectfully submit that this conclusion has no support in fact, theory or law.

Applicants also respectfully submit that the Examiner's conclusion ignores the facts of Applicants explicit disclosure.

Fig. 1a is a schematic illustration of a porous woven material having a layer of symmetrical shaped friction modifying material at least partially covering the surface of the porous woven material.

Fig. 1b is a schematic illustration of a porous woven material having a layer of symmetrical shaped friction modifying material fully covering the surface of the porous woven material.

Fig. 2b is a scanning electron microphotograph showing a porous woven material partially coated with symmetrically shaped friction modifying particles.

Fig. 2c is a scanning electron microphotograph showing a porous woven material partially coated with symmetrically shaped friction modifying particles.

Fig. 2d is a scanning electron microphotograph showing a porous woven material coated with symmetrically shaped friction modifying particles.

Page 18 of the specification and the following Examples further enable the claims.

The useful friction modifying particles comprise a mixture of the geometrically symmetrically shaped friction modifying particles and at least one type of irregularly shaped friction modifying particles such as silica particles; resin powders such as phenolic resins, silicone resins epoxy resins and mixtures

thereof; partial and/or fully carbonized carbon powders and/or particles admixtures thereof; and mixtures of such friction modifying particles. In particular, silica particles such as diatomaceous earth, Celite®, Celatom®, and/or silicon dioxide are especially useful. The silica particles are inexpensive organic materials which bond strongly to the fibrous materials. The silica particles provide high coefficients of friction to the friction material. The silica particles also provide the friction material with a smooth friction surface and provides a good “shift feel” and friction characteristics to the friction material such that any “shudder” is minimized.

Applicants specification clearly is enabling for the claimed particles.

Section 112 requires that an inventor adequately set forth and describe, the manner and process of making and using the invention (the enablement requirement). To fulfill the enablement requirement, an applicant need not describe actual embodiments or examples. Nevertheless, the presence or absence of examples in a patent application is a factor in determining the extent to which claims, particularly broad claims involving an unpredictable technology, are enabled. What is important is that a person of ordinary skill in the art is able to practice the invention without undue experimentation. Johns Hopkins University v. Cellpro, Inc. 152 F.3d 1342, 1354 (Fed.Cir. 1998).

Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

Applicants respectfully traverse the rejection of claim 11, under 35 U.S.C. §112, second paragraph, as being indefinite.

Claims 1 and 9 as amended now recite about 65% to about 80% carbon particles by weight based on the total weight of the friction modifying particles.

Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

Applicants respectfully traverse the rejection of claims 1 – 3, 7 – 17, 28, and 29 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over EP 1203897 to Lam.

Claims 1 – 3, 7 – 10, 12, 14 – 15 and 17 patentably distinguish over Lam in the recitation of wherein the secondary layer comprises about 20% to about 35%, by weight, of symmetrically shaped silica particles, or about 65% to about 80%, by weight, carbon particles, based on the total weight of the friction modifying particle.

Nowhere does Lam disclose or suggest this.

Nowhere does lam disclose or suggest that the secondary layer comprises 20% to 35%, by weight, of symmetrically shaped silica particles, based on the total weight of the friction modifying particles.

Nowhere does Lam disclose or suggest that the secondary layer comprises 65% to 80%, by weight, carbon particles, based on the total weight of the friction modifying particles.

Nowhere does Lam disclose the combination of symmetrically shaped silica particles and carbon particles.

Not only has the Examiner failed to make out a case of anticipation, but the Examiner also has failed to establish a case of prima facie obviousness.

The Examiner points to the entire document of EP 1,203,897 and specifically to paragraphs 0001, 0024, 0025, 0059, 0060) to support his position. However, Applicants respectfully submit that these paragraphs and the entire document fail to disclose or suggest what is claimed.

Applicants respectfully submit that no basis in fact or theory exists to support the Examiner's rejection. Lam is deficient.

The Examiner's position attempts to add to Lam what is not there.

The rejection fails to establish a prima facie case of obviousness because the applied prior art does not teach or suggest the key elements of what is claimed. See In re Kahn, 441 F.3d 977, 985-86, 78 U.S.P.Q. 1329, 1335 (Fed.Cir. 2006). Applicants have overcome the rejection by showing insufficient evidence of prima facie obviousness; In re Piasecki, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed.Cir. 1984).

Applicants also respectfully submit that the Lam reference is complete and has been designed to provide specific performance characteristics and that it is not possible to add or replace process steps without entirely reengineering the

teachings of the reference. In addition, there is no teaching or suggestion in either of these references that the complete process that has been designed to achieve specific results can or should be modified.

Lam is deficient and US 6,875,711 (Chen) does not supply those deficiencies. Chen does not disclose or suggest what is claimed. Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

Therefore, Applicants respectfully submit that claims 1 – 3, 7 – 10, 12 – 17 and 28 as amended are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

EMCH, SCHAFFER, SCHAUB  
& PORCELLO CO., L.P.A.



Patrick P. Pacella  
Reg. No. 25,463

P.O. Box 916  
Toledo, Ohio 43697  
Ph: (419) 243-1294  
Fax (419) 243-8502  
PPP/kab